

Application No. 10/602,128  
Amendment. dated January 26, 2005  
Reply to Office Action of November 26, 2004

### **REMARKS**

This amendment is submitted in response to the Final Office Action mailed November 26, 2004. Claims 1-13 remain pending in the application and stand rejected. Claims 4, 5, 12 and 13 have been amended herein. Applicants respectfully request reconsideration in view of the following remarks.

### **Finality Of The Office Action**

Applicants that submit that the finality of this Office Action was improper under MPEP §706.07(a). Specifically, MPEP §706.07(a) states that "[a] second or any subsequent action on the merits in any application . . . should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed." Originally filed claims 1 and 10 in this application recited objective lenses having "oppositely disposed first peripheral edges . . . defined by a first radius . . . and . . . oppositely disposed second peripheral edges . . . defined by at least one second radius." The Examiner rejected claims 1 and 10 over U.S. Patent No. 4,865,438 to Wada and U.S. Patent No. 3,273,456 to Feinbloom. Both Wada and Feinbloom are directed to optical loupe systems having flat-edged lenses. Nevertheless, the Examiner applied these references, asserting that the flat edges of Wada and Feinbloom could be interpreted as being defined by radii, albeit infinite radii.

In the Amendment filed September 10, 2004, Applicants responded that this interpretation of the flat-edged lenses of Wada and Feinbloom was inconsistent with

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the Specification. In an effort to advance prosecution of the application, however, Applicants amended claims 1 and 10 to clarify that the peripheral edges defined by the first and second radii, respectively, were arcuate in shape. Accordingly, Applicants assert that the amendment of claims 1 and 10 to recite arcuate peripheral edges should reasonably have been expected by the Examiner, particularly in view of the Specification which disclosed only embodiments having arcuate peripheral edges. For at least these reasons, Applicants respectfully assert that the finality of this Office Action is improper in view of MPEP §706.07(a), and respectfully request that the finality of the Office Action be withdrawn.

#### **Objections to the Specification**

The Specification was objected to for various informalities which have been corrected by amendment, as suggested by the Examiner. Accordingly, Applicants respectfully request that the objections to the Specification be withdrawn.

The Examiner also objected to the Amendment filed on September 10, 2004, for allegedly introducing new matter. While Applicants disagree that the amendment added new matter, the Specification and claims have been amended herein to further clarify that the diameters in Tables 1 and 2, and the corresponding tables in claims 4, 5, 12 and 13 represent the maximum clear lens aperture diameters of the parent lens elements. As set forth in the amendment file September 10, 2004, and further supported by a declaration of John Rogers to be filed in this Application, Applicants assert that persons skilled in the art, having read the application, would have

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understood that the diameters in the tables as-filed were the maximum clear lens aperture diameters of the parent lens elements. Moreover, persons skilled in the art would have understood that material was to be removed from these parent lens elements to form the desired non-circular lens shapes of the present invention. Accordingly, Applicants assert that no new matter has been added by amending the Specification and claims to include such description, and Applicants respectfully request that this objection be withdrawn.

Applicants further note that the Examiner appears to have misinterpreted the diameters  $D_1$ ,  $D_2$ , and  $D_3$ ,  $D_4$ , in the tables, to represent "the diameters of both sides of the lens," (i.e., diameters defining the first and second peripheral edges). (See Office Action mailed November 26, 2004 at item 6, paragraph 3.) Applicants respectfully note that this interpretation is incorrect. Rather, the diameters  $D_1$  and  $D_2$  represent the clear lens aperture diameters on the respective refractive surfaces of a single lens element. Specifically,  $D_1$  represents the clear lens aperture diameter on the eyepoint side of the lens element, and  $D_2$  represents the clear lens aperture diameter on the object side of lens element. Similarly,  $D_3$  and  $D_4$  represent the clear lens aperture diameters on the eyepoint and object sides, respectively, of an individual lens element. As set forth in the declaration of John Rogers, discussed above, persons skilled in the art would have understood these diameter notations to mean the eyepoint and object side clear lens aperture diameters, and not the diameters of the first and second peripheral edges of a non-circular lens, as suggested by the Examiner.

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**Claims Rejected under 35 U.S.C. §112**

Claims 4, 5, 12 and 13 stand rejected under 35 U.S.C. §112, with regard to the recitation of maximum diameter values for the lens elements. As discussed above, with respect to the objections to the Specification, claims 4, 5, 12 and 13 have been amended to clarify that the diameters set forth in the tables of these claims represent the maximum clear lens aperture diameters of parent lens elements. Applicants assert that persons skilled in the art would have understood from the tables, as-filed, that the diameters set forth therein were the maximum clear lens aperture diameters of parent lens elements from which the desired non-circular shaped lenses of the present invention were to be formed. In further support of this assertion, a declaration of John Rogers will be filed in this application.

Claims 4, 5, 12 and 13 were also rejected under 35 U.S.C. §112, first paragraph, with respect to the recitation of a single eye piece lens and a two element objective lens. Claims 4, 5, 12 and 13 have been amended herein to correct typographical errors associated with those claims. As amended, claims 4 and 12 recite optical loupes that are suited for mounting through the lenses of a user wearable device. Claims 5 and 13 recite optical loupes that are suited for flip-up mounting to a user wearable device. Accordingly, Applicants respectfully request that the rejections of claims 4, 5, 12 and 13 under 35 U.S.C. §112, first paragraph, be withdrawn.

Claims 1-11 stand rejected under 35 U.S.C. §112, first paragraph, for allegedly

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failing to provide support for the claimed non-circular shaped lenses. Specifically, the Examiner refers to the diameters ( $D_3$ ,  $D_4$ ) of lens element 4 in Table 2. Applicants assert that the Examiner has misinterpreted these diameters as corresponding to the recited first and second oppositely disposed peripheral edges of the lenses. As discussed above, this interpretation is incorrect. Rather, the diameters  $D_3$ ,  $D_4$  (as well as the diameters  $D_1$ ,  $D_2$ ) represent the clear lens aperture diameters of individual lens elements, at the eyepoint side and the object side, respectively. Applicants assert that this notation would have been understood as such by those skilled in the art, as discussed above and as supported by the declaration of John Rogers. For at least these reasons, Applicants respectfully request that the rejections of claims 1-11 under 35 U.S.C. §112 be withdrawn.

#### **Objections To The Claims**

Claims 5, 12 and 13 were rejected for various informalities related to claim language. These claims have been amended as suggested in the Office Action, and Applicants respectfully request that the objections to these claims be withdrawn.

#### **Claims Rejected Under 35 U.S.C. §103**

Claims 1 and 8-10 stand rejected 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,865,438 to Wada in view of U.S. Patent No. 4,833,890 to Kelman.

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Claims 1 and 10 are the only independent claims of this rejected group. Claim 1 is directed to a magnification loupe having an objective lens with a non-circular shape, "wherein at least two oppositely disposed arcuate first peripheral edges are defined by a first radius and wherein at least two oppositely disposed arcuate second peripheral edges are defined by at least one second radius." Claim 10 is directed to a magnification viewer comprising a magnification loupe as recited in claim 1.

Applicants respectfully traverse the rejections of claims 1 and 10 over Wada in view of Kelman because Wada does not teach each and every element recited in the claims and Kelman does not cure these deficiencies. Specifically, the Examiner admitted that Wada does not teach or suggest "the arcuate shape of the peripheral surfaces of the objective lens element," (Final Office Action at page 10). Kelman does not teach or suggest a modification of Wada that cures this deficiency. Specifically, Kelman is directed to an Intraocular lens that is intended to be implanted in a human eye. The lens has a generally oblong, rectangular or oval/elliptical shape so that the lens may be inserted through a minimum width incision made in the patient's eye. In contrast, the optical loupes of the present invention are intended to be mounted to a user wearable device, such as a pair of spectacles. The claimed optical loupes do not contain lenses that are intended to be inserted within a patient's eye, and therefore Kelman does not teach or suggest making the lenses of the optical loupes of Wada in an oblong, oval or elliptical shape. Accordingly, Applicants respectfully request that the rejections to claims

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1 and 10 over Wada in view of Kelman be withdrawn.

Claims 8 and 9 each dependent from independent claim 1, and are therefore in condition for allowance for at least the reasons stated above for claim 1. Accordingly, Applicants respectfully request that the rejections of claims 8 and 9 over Wada in view of Kelman be withdrawn.

Claims 1-3, 6, 8 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,273,456 to Feinbloom in view of Kelman. Claims 1 and 10 are the only independent claims of this rejected group, and are directed to a magnification loupe and a magnification viewer, respectively, as discussed above. Applicants respectfully traverse the rejections of claims 1 and 10 over Feinbloom in view of Kelman because Feinbloom does not teach or suggest each and every element recited in claims 1 and 10, and Kelman does not cure these deficiencies. Specifically, the Examiner admits that Feinbloom does not teach or suggest the claimed arcuate shape of the objective lenses. Kelman does not teach or suggest a modification of Feinbloom that cures these deficiencies, for at least the reasons discussed above. Accordingly, Applicants respectfully request that the rejections of claims 1 and 10 over Feinbloom in view of Kelman be withdrawn.

Claims 2, 3, 6 and 8 each depend from independent claim 1 and are therefore in condition for allowance for at least the reasons stated above for claim 1. Accordingly, Applicants respectfully request that the rejections of claims 2, 3, 6 and 8 over Feinbloom

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in view of Kelman be withdrawn.

Claims 7 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Feinbloom and Kelman in further view of U.S. Patent No. 6,061,189 to Caplan et al. As a preliminary matter, Applicants note that several references to Caplan et al. are of record in the application. The Office Action at page 13 was not specific as to which particular reference to Caplan et al. the Examiner was applying in the rejection under 35 U.S.C. §103(a). Based on the Office Action mailed June 10, 2004, Applicants presume that the Examiner intended to apply U.S. Patent No. 6,061,189. If this is incorrect, Applicants respectfully request that the Examiner contact the undersigned attorney to resolve this issue.

Claim 7 depends from independent claim 1, and claim 11 depends from independent claim 10. Accordingly, claims 7 and 11 include each and every element recited in the claims from which they depend. Applicants respectfully traverse the rejections of claim 7 and 11 because the combination of Feinbloom and Kelman does not teach or suggest each element of these claims, as discussed above with respect to the rejections of claims 1 and 10, and because Caplan et al. does not cure these deficiencies. Specifically, Feinbloom does not teach or suggest arcuate peripheral edges, as admitted by the Examiner. Kelman is directed to an intraocular lens having an oblong, oval or elliptical shape so that it can be inserted through a minimum width incision in a patient's eye, and does not teach or suggest modifying the shape of the



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lenses of an optical loupe system. Caplan et al. does not cure these deficiencies. Specifically, Caplan et al. is directed to a binocular viewer having circular objective lenses. For at least these reasons, Applicants respectfully request that the rejections of claims 7 and 11 over the combination of Feinbloom and Kelman in further view of Caplan et al. be withdrawn.

In view of the foregoing amendments and the remarks presented herein, Applicants believe this case is in condition for allowance and respectfully request allowance of the pending claims. If the Examiner believes any detailed language of the claims requires further discussion, the Examiner is respectfully asked to telephone the undersigned attorney so that the matter may be promptly resolved. The Examiner's prompt attention to this matter is appreciated.

Applicants are of the opinion that no additional fee is due as a result of this amendment. If any charges or credits are necessary to complete this communication, please apply them to Deposit Account No. 23-3000.

Respectfully submitted,

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